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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) CHA92001001US1
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope address to "Mail Stop AF, Commissioner Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		<p>Application Number 09/839,066</p> <p>Filed 08/24/2001</p> <p>First Named Inventor Mitchell et al.</p> <p>Art Unit 2624</p> <p>Examiner Wenpeng Chen</p>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 34,336</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p>		
<p style="text-align: right;"><i>David C. Goldman</i> Signature</p> <p>David C. Goldman Typed or printed name</p> <p>(518) 449-0044 Telephone number</p> <p>July 24, 2006 Date</p>		
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14, and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Mitchell et al

Confirmation No.: 4252

Serial No.: 09/939,066

Group Art Unit: 2624

Filed: August 24, 2001

Examiner: Chen

Title: Managing Image Storage Size

Docket No.: CHA920010012US1  
(IBMC-0023)

Pre-Appeal Brief Request For Review

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program established in July of 2005, Applicant requests that a panel of examiners formally review the legal and factual basis of the rejections set forth in the above-identified patent application. Applicant believes that a pre-appeal brief conference is proper in the instant case because the rejections of the claimed invention are based on clear errors in fact and as a result are not suitable for the filing of an appeal brief at this time.

Claims 1-4, 11-12, 14-19, 30-36, 38-39, and 41 are rejected under 35 U.S.C. §102(e) as being anticipated by Keller et al. (US Patent Application Publication Number 2002/0102028). Independent claims 1, 30, 39 and 41, from which claims 2-4, 11-12, 14-19, 31-36 and 38 depend directly or indirectly from, each recite the limitation of replacing the image with a size-reduced image version such that the size-reduced image version is the only version of the image stored in the database. Keller does not teach having a size-reduced image version that is the only version of the image stored in the database.

As stated in Applicant's Amendment of March 23, 2006, on page 11, paragraph 2, Keller teaches that the temporary storage medium 11 within the image server 1 stores compressed image data S1 and S2 along with the original image data S org (see FIG. 1 and paragraph 61 in Keller). Keller further teaches that original image data S org can be compressed and stored along with S1 and S2 in the temporary storage medium 11 (see Keller, paragraph 61, sentence 4). Therefore, Keller can store anywhere from two to three size-reduced images of the same image in the image server 1. Regardless of what form S org takes, the temporary storage medium 11 stores three images that relate to S org. In addition, if one included the storage of S org in the archive 12 of the image server 1, which is not in a compressed state, then the image server of Keller can store up to four images.

No matter how the storage capabilities of the image server 1 of Keller are interpreted; the temporary storage medium 11 on its own, the archive 12 on its own or the combination of both the temporary storage medium and the archive, none anticipate the claim limitation of having a size-reduced image version that is the only version of the image stored in the database. In particular, the temporary storage medium 11 stores three size-reduced images of the image, the archive stores S org but it is not in a compressed state, and the combination of the temporary storage medium and archive store a total of four images. Accordingly, Applicant submits that there is a clear factual deficiency in the §102(e) rejection under Keller. As a result, Applicant submits that Keller does not anticipate independent claims 1, 30, 39 and 41. Claims 2-4, 11-12, 14-19; and 31-36, 38 depend directly or indirectly from now presumably allowable claims 1 and 30, respectively, and thus are in allowable condition by dependency. Therefore, Applicant requests that the panel of examiners reconsider and remove the §102(e) rejection of claims 1-4, 11-12, 14-19, 30-36, 38-39, and 41 under Keller.

The rejection of claims 5-10, 13, 20; and 37 which depend from now presumably allowable claims 1 and 30, respectively, is believed to be moot in view of the clear error in fact made with respect to the §102(e) rejection of the independent claims. Therefore, Applicant requests that the panel of examiners reconsider and remove the various §103(a) rejections of claims 5-10, 13, 20 and 37.

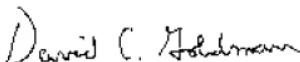
Claims 21-23 and 25-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Keller in view of Morris et al. (US Patent Number 5,153,936). Applicant respectfully traverses this §103(a) rejection and submits that claims 21-23 and 25-29 are patentable over the combination of Keller in view of Morris et al. (hereinafter Morris). Independent claim 21, like claims 1, 30, 39 and 41, recites that the size-reduced image version is the only version of the image stored in the database. Morris, like Keller stores more than one size-reduced image version in its image storage (see FIG. 1 and col. 9, lines 37-53). Since Morris does not provide any teaching or motivation that suggests the desirability of having the size-reduced image version as the only version of the image stored in image storage, Applicant submits that the rejection of claims 21-23 and 25-29 under the combination of Keller in view of Morris is based on a clear error in fact. Accordingly, Applicant submits that claims 21-23 and 25-29 are patentable over the combination of Keller in view of Morris. Therefore, Applicant requests that the panel of examiners reconsider and remove the §103(a) rejection of claims 21-23 and 25-29 under Keller in view of Morris.

The §103(a) rejection of claim 24 which depends from now presumably allowable claim 21, is believed to be moot in view of the clear error in fact made with respect to the rejection of independent claim 21. Therefore, Applicant requests that the panel of examiners reconsider and remove the §103(a) rejection of claim 21.

In view of the foregoing remarks, Applicant requests that the panel of examiners allow claims 1-39 and 41 or reopen the instant case for further prosecution on the merits.

If the panel of examiners has any questions regarding the present patent application, the panel can call Applicant's attorney, David C. Goldman, at telephone number (518)-449-0044.

Respectfully submitted,



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Dated: July 24, 2006

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